

REMARKS

Claims 1-5 are pending in the present application. No new matter has been added.

The Present Invention

The present invention is described in detail on page 3 of the Amendment mailed on September 1, 2005 and the Examiner is directed therein for a detailed description of the invention.

REJECTION UNDER 35 U.S.C. §§102 AND 103

The Examiner has rejected claims 1-3 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being obvious, in view of Minayoshi et al., U.S. Patent No. 5,494,651 ("Minayoshi").

The Examiner asserts that, "[Minayoshi] shows vaterite having the claimed size; see figs. 15 and 20 and also column 8." (Office Action of July 28, 2006, page 2).

For a claim to be rejected as anticipated under 35 U.S.C. §102, it must be shown that the prior art reference teaches or suggests all of the claimed elements and limitations. (M.P.E.P. §706.02).

The present invention is not anticipated by Minayoshi, because while the present invention specifies that the vaterite calcium carbonate is in the form of an aggregate, Minayoshi explicitly teaches a calcium carbonate material that is not in the form of an aggregate:

An object of the present invention is to provide spherical, ellipsoidal and plate-like vaterite type calcium carbonate almost

free from secondary aggregation and excellent in dispersibility and a manufacturing method thereof. (Column 1, line 65 - Column 2, line 3).

The “secondary aggregation” referred to in Minayoshi, above, is apparently identical to the use of “aggregate” in the present claims. Compare for example Minayoshi’s use of “secondary aggregation” at Column 1, lines 42 – 49 with the usage in the present claims at paragraphs 0018 – 0020 of the Specification.

Additionally, in the Office Action of November 16, 2005 the Examiner makes a further argument under 35 U.S.C. §103 that:

The reference does not explicitly teach the claimed properties per se, however appears to possess them due to the pictures. The abrasion resistance of claims 4 and 5 are deemed met since the material is the same in composition and size. No differences are seen. (Office Action of July 28, 2006, page 2).

Applicants respectfully disagree with the Examiner’s analysis because the Examiner has not made an adequate showing to support an assertion of inherency. (Although the Examiner has not specifically used the word “inherency”, the Examiner appears to acknowledge a similar argument with respect to the now withdrawn Goffin reference (U.S. Patent No. 5,290,353) as based on inherency, see Office Action of July 28, 2006, page 3.) In order to support an assertion that an element or feature is inherently present in the prior art, the Examiner must show, by objective evidence or cogent technical reasoning, that the missing element necessarily flows from the teachings of the prior art. The fact that an element may be present in the prior art is not sufficient to establish inherency. (M.P.E.P. §2112).

The Examiner has not met this burden. The only showing offered by the Examiner in support of the inherency suggestion is the Examiner's assertion that, "the abrasion resistance of claims 4 and 5 are deemed met since the material is the same in composition and size. No differences are seen." (Office Action of July 28, 2006, page 2). Applicants respectfully assert that this showing is not adequate to support the Examiner's inherency assertion. As stated above, the M.P.E.P. requires that the missing element necessarily flows from what is taught by the prior art. The Examiner asserts only that the properties of Minayoshi are "expected" to be identical to the elements recited in claims 4-5. The Examiner has made no showing that the elements of claims 4-5 must necessarily flow from the properties disclosed in Minayoshi. This is especially important because, as discussed above, there is a significant difference between the material of Minayoshi, which excludes aggregates, and that set forth in the present claims, which specifically includes aggregates.

Appl. No. 10/717,310
Amendment transmitted on April 12, 2007
Reply to Office action of July 28, 2006

Customer No. 26057
Att'y Docket No. 02-215

Because of these important and substantial differences between Minayoshi and the subject matter of claims 1-5, these claims meet the requirements for novelty and nonobviousness established by 35 U.S.C. §102 and 35 U.S.C. §103. Reconsideration and withdrawal of the rejection of these claims in view of Minayoshi is respectfully requested.

CONCLUSION

Reconsideration and withdrawal of the rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

Dated: 12 April 2007
J. M. Huber Corporation
333 Thornall Street
Edison, NJ 08837-2220
(732) 603-3674

David Goodrich
David M. Goodrich
Reg. No. 42,592